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David S. Resnick
Nixon Peabody LLP
100 Summer Street
Boston MA 02110

In re Application of:
PACHUK, et al.
Application No.: 10/560,377
PCT Appln. No.: PCT/US2004/019229
Int. Filing Date: 10 June 2004
Priority Date: 12 June 2003
Attorney Docket No.: 26788-024
For: CONSERVED HBV AND HCV SEQUENCES
USEFUL FOR GENE SILENCING

DECISION

This decision is in response to the petitions under 37 CFR 1.182 and 37 CFR 1.78 filed 04 December 2009 in the United States Patent and Trademark Office (USPTO). Applicant has provided payment of the appropriate petition fees.

BACKGROUND

Applicant filed international application PCT/US2004/019229 on 10 June 2004. The application claimed an earliest priority date of 12 June 2003, and designated the United States. The 30 month period for payment of the basic national fee in the U.S. ended as of midnight on 12 December 2005.

On 12 December 2005, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, among other items, the requisite basic national fee as required by 35 U.S.C. 371(c)(1);

On 01 October 2007, a Notice of Acceptance (Form PCT/DO/EO/903) was mailed to applicant, reflecting a date under 35 U.S.C. 371(c)(1), (2) and (4) of "06/19/2006."

On 04 December 2009, applicant filed the petitions discussed herein.

DISCUSSION

I. Petition Under 37 CFR 1.182

The petition states that

A petition under 37 CFR §1.182 is submitted herewith to correct an inadvertent error on the part of the Applicant at the time of National Stage Entry (June 19, 2006) for the above-noted U.S. patent application. The petition seeks to establish a separate "bypass" Continuation-In-Part application of the original PCT (PCT/US2004/019229).

The USPTO has adopted a bright-line test for determining whether application papers will be processed under 35 U.S.C. 371 or alternatively under 35 U.S.C. 111(a). Under this standard, any intended filing of an international application as a national stage application must clearly and unambiguously be identified as such and must satisfy all of the conditions set forth in 35 U.S.C. 371(c). The official PTO Notice published in the Official Gazette at 1077 OG 13

entitled "Minimum Requirements for Acceptance of Applications Under 35 U.S.C. 371 (the National Stage of PCT)" states, in part, the following:

The Patent and Trademark Office is continuing to receive application papers which do not clearly identify whether the papers (1) are being submitted to enter the national stage of the Patent Cooperation Treaty (PCT) under 35 U.S.C. 371 or (2) are being filed as a regular national application under 35 U.S.C. 111.

To clearly indicate an international application is being filed under 35 U.S.C. 371 the applicant should use the "Transmittal Letter for United States Designated Office" (Form PTO-1390) as the transmittal letter.

Alternatively, one of the following indications may be used:

- 1) the applicant shall clearly state in the transmittal or cover letter that he or she is filing under 35 U.S.C. 371 or entering the national stage under PCT; or
- 2) the applicant clearly identifies in the oath or declaration the specification to which it is directed by referring to a particular international application by PCT Serial Number and International Filing Date and that he or she is executing the declaration as, and seeking a U.S. Patent as, the inventor of the invention described in the identified international application.

Inspection of the correspondence filed on 12 December 2005 reveals that the Transmittal Letter identified the accompanying papers and fees as directed toward the national stage under 35 U.S.C. 371 of PCT/US2004/019229. The Transmittal Letter specifically indicated that the basic national fee was being paid. These indicia constituted instructions that processing under 35 U.S.C. 371 was desired, and no contrary instructions requesting processing under 35 U.S.C. 111(a) appear to have been present on 12 December 2005. Therefore, the submission was properly processed under 35 U.S.C. 371.

Counsel requests that this application, intended as a continuation-in-part, be converted to an application under 35 U.S.C. 111(a). The situation presented in the instant case is analogous to the filing of a similar preliminary amendment or substitute specification in a request for a CPA or RCE, as discussed at MPEP 201.06(d). As such, it would not be appropriate to convert this application. Instead, under these circumstances, petitioner is required to file a petition under 37 CFR 1.182 identifying and requesting removal from the present application file of the specific "disclosure materials that differ from" those present in the international application, and requesting treatment of said materials being removed as a new (CIP) application filed under 35 U.S.C. 111(a). Any such petition should be accompanied by the appropriate filing fee payment for the application as filed under 35 U.S.C. 111(a), as well as any application papers which would be required to create a complete application file (e.g., specification, claims and drawings) for the 35 U.S.C. 111(a) application.

In the instant case, applicant has filed such a petition under 37 CFR 1.182, identifying the specific papers presently filed which are to be used in the newly-created application under 35 U.S.C. 111(a). However, applicant is advised that because a significant period of time has elapsed from the filing of the above-captioned application, before such petition can be granted, applicant is required to file a terminal disclaimer under the provisions of 37 CFR 1.321 (b) disclaiming the terminal part of the term of a patent to be granted equivalent to the period between the filing date of a grantable petition under 37 CFR 1.182 to create the CIP application and the filing date under 35 U.S.C. 111 (a) of such application.

II. Petition Under 37 CFR 1.78

A decision on the petition under 37 CFR 1.78 will be held in abeyance pending resolution of any renewed petition under 37 CFR 1.182.

CONCLUSION

For the reasons stated above, the petition under 37 CFR 1.182 is **DISMISSED**.

Any further correspondence with respect to this matter may be filed electronically via EFS-Web selecting the document description "Petition for review and processing by the PCT Legal Office" or by mail addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



Derek A. Putonen
Attorney Advisor
Office of PCT Legal Administration
Tel: (571) 272-3294